

**REMARKS**

Reconsideration of this application is respectfully requested in view of the foregoing amendment and the following remarks. Claims 9-16, 21-23, and 25-36 are currently pending. Claims 9-16, 21-23, and 25-36 are rejected. Claims 9, 21-23, and 25-27 have been amended. No new matter has been added.

**Double Patenting Rejection**

Claims 22, 23, 26-28, 32, and 35 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3 and 6 of U.S. Patent No. 6,675,151. Specifically, the Examiner asserts that:

... Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 22, 23, 26-28, 32, and 36 each contain obvious modifications to claims 3 or 6 of U.S. Patent No. 6,675,151.

As per claims 22, 23, 26-28, 32 and 36 of the instant application, the claims do not recite first receiving absentee information representing absent workers as recited in claims 3 and 6 of U.S. Patent No. 6,675,151, thus making claims 22, 23, 26-28, 32 and 36 broader. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to omit the step of receiving absentee information if the step was not desired or required as part of the overall invention. See MPEP 2144.04, II, A.

Additionally, as per claim 23 of the instant application, the claim replaces the word, Internet, in claim 3 of U.S. Patent No. 6,675,151 for the phrase, instant messaging. It is old and well known in the art that instant messaging is a type of communication able to be performed over a network such as the Internet. Thus, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to replace Internet for instant messaging as doing so covers a particular type of communication that uses Internet technology, thus expanding the application of the instant invention.

Additionally, as per claim 27 of the instant application, the claim recites a computer readable medium that essentially performs the steps recited, in claim 3 of U.S. Patent No. 6,675,151. At the time of the invention, it would have been obvious to recite a computer readable medium that performs the steps of a claimed method since doing so simply covers another statutory class.

The undersigned representative acknowledges this rejection and will submit a terminal disclaimer when the present claims are in condition for allowance, if deemed necessary at that time.

**Rejection of Claim 21 under 35 USC § 101**

Claim 21 stands rejected under 35 USC § 101 because the claimed invention is directed to non-statutory subject matter. Specifically, the Examiner asserts that:

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

As per the first prong of the test, for a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences) and therefore are found to be non-statutory subject matter. For a process claim to be satisfactory, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, the method of claim 21 merely recites the steps for receiving absentee information, generating substitute worker lists and contacting potential substitute workers; however, the recited steps do not apply, involve, use, or advance the technological arts since all of the recited steps can be performed manually by a person and without the need of a computer or other processing device. Additionally, even if the communication link was a telephone, the use of such technology is considered trivial, as the telephone could potentially be used to merely receive a call from a worker indicating their absence. The use of technology in the body of the claim must not be nominal or trivial.

As per the second prong of the test, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention produces substitute worker lists (i.e., concrete) and contacts the substitute workers to fill in for an absent worker position (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claim 21 is directed to non-statutory subject matter.

This rejection is respectfully traversed. This rejection has been rendered moot in view of the recent decision by the Board of Patent Appeals and Interferences decision in *Ex Parte Lundgren*. Appeal No. 2003-2088 (Bd. Pat. App. & Int. Sept. 28, 2005). In *Lundgren*, the Board reversed an Examiner's rejection under § 101 that claims were deficient in the "technological arts." In view of *In re Musgrave*, the Board also found that "mental steps" were not a basis for a rejection under § 101. 431 F.2d 882 (CCPA 1970). In *Diamond v. Diehr*, the Supreme Court recognized

only three categories of inventions excluded from patent protection: laws of nature, physical phenomena, and abstract ideas. 450 U.S. 175 (1981). Claim 21 is not directed to laws of nature, physical phenomena, or abstract ideas. Thus, a “technological arts” rejection is improper in view of *Lundgren*.

The claimed invention as a whole must be useful and accomplish a practical application, *i.e.*, a useful, concrete and tangible result. *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368, 1373-74 (Fed. Cir. 1998). The purpose of this requirement is to limit patent protection to inventions that possess a certain level of “real world” value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research. *See Brenner v. Manson*, 383 U.S. 519, 528-36 (1966); *In re Fisher*, 421 F.3d 1365 (Fed. Cir. 2005); *In re Ziegler*, 992 F.2d 1197, 1200-03 (Fed. Cir. 1993). Accordingly, the present application discloses the “real world” value of the invention of claim 21 and is clearly more than just an idea or concept.

Furthermore, the rejection of claim 21 is improper in view of the technological arts that are actually present in the claim. In view of the specification in the present application, one of ordinary skill in the art recognizes that the steps of claim 21 are conducted using a computer, *i.e.*, in the technological arts. It is evident from the figures and the specification that certain steps of this system were intended to be computer-implemented.

Accordingly, it is respectfully requested that the rejection of claim 21 under 35 U.S.C. § 101 be reconsidered and withdrawn.

**Rejection of claims 9-16, 21, and 25 under 35 USC § 102(a)**

Claims 9-16, 21, and 25 stand rejected under 35 U.S.C. § 102(a) as being anticipated by the SubfinderTM System (“Subfinder”). Specifically, the Examiner asserts that:

As per claim 9, Subfinder discloses a substitute fulfillment system that identifies and secures substitute workers for a plurality of different organizations comprising:

a database comprising worker records, said worker records having information associated with workers for each of the organizations, and substitute records, said substitute records having information associated with at least one substitute worker (reference A, paragraphs 2 and 5; reference D, paragraph 8;

Subfinder utilizes a database that contains worker records where the workers are teachers and the worker records include teacher availability, teacher skills and teacher preferences. The teachers are associated with various schools within school districts.);

a server coupled to the database, the server is configured for:

receiving an absentee list of one or more absent workers from an organization via at least one communication link coupled to the server (reference A, paragraph 2; reference B, paragraph 1; Teachers call into the system and record their absences.);

generating in response to receiving the absentee list one or more lists of one or more potential substitute workers who can fill in for each absent worker on the absentee list using the worker records associated with the absent worker and the substitute records (reference A, paragraph 2; reference B, paragraph 1; For each absent teacher, a list of qualified substitute teachers is generated and each substitute teacher is contacted to fill in for the absent teacher.); and

contacting potential substitute workers listed on each of the generated lists until one of the substitute workers in each of the generated lists agrees to fill in for the absent worker or until all of the generated lists are exhausted (reference A, paragraph 2; reference B, paragraphs I and 3; The system automatically contacts substitute teachers on the lists until the absent teacher position is filled or until the system has contacted everyone on the lists.).

As per claim 10, Subfinder discloses the substitute fulfillment system of claim 9 wherein each of the least one communication link is a link selected from the group consisting of a telephone communication link or an Internet communication link (reference A, paragraph 2; reference C, paragraph 6; Subfinder uses a telephone communication link to receive absentee information and to contact and secure substitute teachers for the absent positions.).

As per claim 11, Subfinder discloses the substitute fulfillment system of claim 9 wherein the server generates the list of one or more substitute workers using a preferred list of substitute workers associated with the worker record for the absent worker (reference A, paragraph 2; reference B, paragraphs 1 and 3; reference D, paragraph 8; Subfinder generates preferred lists of substitute teachers based on criteria such as substitute teachers the absent teacher has designated and skit Is/specialties/qualifications of substitute teachers.).

As per claim 12, Subfinder discloses the substitute fulfillment system of claim 9 wherein the server is further configured to generate a list of substitute workers and names of the absent workers who the substitute workers will be filling in for a given organization and to transmit the generated list of substitute workers and names of the absent workers who the substitute workers will be filling in for to the given organization via the at least one communication link (reference A, paragraphs 4 and 9; Principles and other administrators have the ability to call into the system to receive reports on absentee information as well as substitute teacher information. Reports can also be faxed.).

As per claim 13, Subfinder discloses the substitute fulfillment system of claim 9 further comprising an interactive voice response system controlled by the server for interacting with a potential substitute worker from the generated list of potential substitute workers via at least one telephone communication link whereby the potential substitute worker is secured for filling in for the absent worker (reference B, paragraphs 4-8; Absent and substitute teachers use a combination of voice and telephone number prompts to interact with Subfinder. Absent teachers indicate their absence and any other special messages for the substitute. Substitute teachers indicate a desire to accept or decline a job.).

As per claim 14, Subfinder discloses the substitute fulfillment system of claim 9 wherein the server is further configured to receive a message via the at least one communication link and to forward the received message to the substitute worker who agrees to fill in for the absent worker via the at least one communication link (reference B, paragraphs 4 and 5; Absent teachers may leave messages for substitute teachers via a telephone link.).

As per claim 15, Subfinder discloses the substitute fulfillment system of claim 9 wherein the organizations are unaffiliated (reference B, paragraph 10; Subfinder may be used across multiple school districts, which are not affiliated with each other.).

As per claim 16, Subfinder discloses the substitute fulfillment system of claim 9 wherein the workers are teachers and the substitute workers are substitute teachers (reference B, paragraph 1).

Claims 21 and 25 recite substantially similar subject matter to claim 9 above. Therefore claims 21 and 25 are rejected on the same basis as claim 9 above.

The undersigned representative respectfully traverses the rejection of claims 9-16, 21, and 25 under 35 U.S.C. § 102(a) as being anticipated by the Subfinder. Regarding claim 9, Subfinder does not disclose, *inter alia*, "A substitute fulfillment system that identifies and secures substitute workers for a plurality of different organizations comprising: a database comprising worker records, said worker records having information associated with workers for each of the organizations, and substitute records, said substitute records having information associated with at least one substitute worker; a server coupled to the database, the server is configured for: receiving an absentee list of one or more absent workers from an organization via at least one communication link coupled to the server; generating in response to receiving the absentee list a list of one or more potential substitute workers who can fill in for each absent worker on the absentee list using the worker records associated with the absent worker and the substitute

records; and contacting potential substitute workers listed on each of the generated lists until one of the substitute workers in each of the generated lists agrees to fill in for the absent worker or until all of the generated lists are exhausted.

The Examiner asserts that “Subfinder discloses … generating in response to receiving the absentee list of one or more potential substitute workers who can fill in for each absent worker on the absentee list using the worker records associated with the absent worker and the substitute records (reference A, paragraphs 2, reference B, paragraph 1; For each absent teacher, a list of qualified substitute teachers is generated and each substitute teacher is contacted to fill in for the absent teacher.)” These cited sections disclose a system that “begins calling from a list of qualified substitutes until the projected absence is filled” (emphasis added, see Reference A, paragraph 2). The list in Subfinder is not generated in response to receiving the absentee list but is a stored priority list or a series of lists. (see Reference B, paragraphs 1, 3, and 6). For example, Subfinder “…calls three or four substitutes that the teacher has designated. If none of those can work, the computer starts calling from a list that the school’s principal has logged in. If no one from that lists accepts, it goes to a central list.” (see Reference B, paragraphs 1 and 6). Subfinder is not generating a list but relying on one or more lists provided by the teacher, the principal, or a central list.

Since Subfinder is not generating a list of potential substitute workers, then Subfinder does not contact “potential substitute workers listed on each of the generated lists” as recited in claim 9 of the present application. (Emphasis added). In order to maintain an anticipatory rejection under 35 U.S.C. §102, a reference must teach each and every element of the claim. *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference).

Since claim 21 similarly recites “A method for performing substitute fulfillment for a plurality of organizations comprising: …generating in response to receiving the absentee list a list of one or more potential substitute workers who can fill in for each absent worker on the absentee list using worker records having information associated with the absent worker and substitute records having information associated with at least one substitute worker; and

contacting potential substitute workers listed on each of the generated lists ...,” claim 21 is also patentable over Subfinder for at least the same reasons recited above with respect to claim 9.

Since claim 25 similarly recites “A computer-readable medium bearing instructions for performing substitute fulfillment for a plurality of different organizations, said instructions being arranged to cause one or more processors upon execution thereof to perform the steps of: ... generating in response to receiving the absentee list a list of one or more potential substitute workers who can fill in for each absent worker on the absentee list using worker records having information associated with the absent worker and substitute records having information associated with at least one substitute worker; and contacting potential substitute workers listed on each of the generated lists ...,” claim 25 is also patentable over Subfinder for at least the same reasons recited above with respect to claim 9.

Thus, for at least these reasons, independent claims 9, 21, and 25, as well as dependent claims 10-16, are patentable over Subfinder in view of Taylor. As a result, the applicants request that the rejection of claims 9-16, 21, and 25 under 35 U.S.C. §102(a) be withdrawn.

**CONCLUSION**

The foregoing is submitted as a full and complete Response to the non-final Office Action mailed July 9, 2005, and early and favorable consideration of the claims is requested. If the Examiner believes any informalities remain in the application which may be corrected by Examiner's Amendment, or if there are any other issues which may be resolved by telephone interview, a telephone call to the undersigned attorney at (202)508-5843 is respectfully solicited.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 50-1458, and please credit any excess fees to such deposit account.

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